

### **REMARKS/ARGUMENTS**

Claims 1, 3-6, 9-15, 24-26 and 30-32 are pending in this application.

#### **Section 102 Rejections**

Claims 1-4, 9-10, and 12-15 and 25-26 and 30-32 were rejected as anticipated by Schein (6,075,575).

Schein shows a remote control with a scrolling roller 20, left/right buttons 32, 34, and directional buttons 40. It also shows separate volume up/down and channel up/down buttons (see Fig. 1).

Claims 1, 10, 11, 24, 25, 30 and 32. The independent claims were previously amended to clarify that movement in one direction selects from among "a plurality of" functions. The current office action now points to Fig. 8A, and says that a plurality of functions can be selected. It is believed that the Examiner is referring to the description of Figs. 8A- 8D in col. 11, lines 38-56. This does indeed show that a user can click the roller on a particular channel, which brings up the options shown in Fig. 8B. It is assumed that this is what the office action is referring to as multiple functions. Applicant does not dispute this.

However, the claims are directed to a combination of using the same element (pointing device in claim 1) to both (1) scroll through and select the function by movement in one direction, and also (2) move in a second direction to select a value of a selected function (e.g., a channel number or an amount of volume).

First of all, the Schein roller 20 only scrolls in a single direction (up and down), and thus is incapable of selecting a value in a second direction (e.g., left-right). It does show selecting values of channels in the up-down direction, but there is no prior selection of channel among other functions.

The clicking on a particular channel does bring up a menu with different functions, but once those functions are selected, there is no ability to vary a value of those functions using the roller with movement in a second direction.

It is possible the claim is being interpreted to say that rolling up and rolling down are two directions. However, there is no showing that rolling up selects a function, and rolling

down selects a value of that function, or vice-versa. Accordingly, this interpretation does not anticipate the claimed invention either.

Schein does have arrow buttons for horizontal movement. First, this is not part of the roller "pointing device." Second, there is no suggestion of using these arrows to select another function. In particular, dedicated volume buttons (see Fig. 2) are shown for the separate volume function.

While the present invention may seem like a small improvement over the prior art, it is a novel and non-obvious improvement, and thus is patentable. Such small improvements make a significant difference in usability. The success of the circular touchpad interface of the Apple iPod attests to this.

Claim 3. Dependent claim 3 sets forth that deactivation of said pointing device selects a value for a selected function. In the embodiment described on page 7, lines 6-9, describes selecting a channel by lifting the thumb off the touchpad. The office action points to channel 8 of Fig. 4B of Schein as showing this. However, applicant can find no description in Schein of deactivation or lifting off performing the select function. Rather, as described by Schein in col. 8, lines 52-54, clicking on the roller is required for selecting. Thus neither this feature alone, nor in combination with the two directional selection of claim 1, is shown. Accordingly, claim 3 is not anticipated by Schein for this reason and the reasons discussed above.

Claim 4. Claim 4 sets forth:

*means, connected to said pointing surface, for detecting contact with said pointing surface and, responsive thereto, sending an activation signal to said video controller; and*

*said video controller being configured to display said menu in response to said activation signal*

One embodiment is described on page 6, lines 28-29 of the application: "In one embodiment, the menu of display 3, 4 or 5 is activated when any touch at all is detected on the touchpad."

It is not clear from the office action what is being relied upon to reject this. The office action refers to an activation signal being sent to video controller 20. Applicant could find no description of an activation signal as a result of simply touching any input in Schein. Thus neither this feature alone, nor in combination with the two directional selection of claim 1, is shown. Accordingly, claim 4 is not anticipated by Schein for this reason and the reasons discussed above.

Claims 12-15. These claims recited motion by the operator relative to a pointing surface of the pointing device, or a sliding motion. The office action refers to scrolling 120 in Fig. 4B. However, 120 is a scroll bar on the display, not an input operated by the user. Scroll bar 120 can be activated by roller 24, but the user moves roller 24 - there is no motion by the user relative to a surface of roller 24, or sliding motion. See col. 9, lines 31 - 36. Rather, the user's finger moves with the surface of roller 24 to turn the roller. Thus neither this feature alone, nor in combination with the two directional selection of the independent claims, is shown. Accordingly, claims 12-15 are not anticipated by Schein for this reason and the reasons discussed above.

The remaining claims are believed allowable for the same reasons as set forth above.

### **Section 103 Rejections**

Claims 5-6 and 11 were rejected as patentable over Schein (6,075,575) in view of Lee et al. (5,545,857).

Lee is cited as showing a touchpad, while Schein shows a roller. However, it is not obvious to combine these references. The present invention, as claimed in these claims, sets forth a touchpad for providing the two directional input for a function in a first direction and a value of a selected function in a second direction. As noted above, Schein does not show such two direction input. A touchpad admittedly can provide two directional input, but there is no motivation to combine since Schein does not show such two directional input. Lee also does not show such a two-directional input for a function in a first direction and a value of a selected

function in a second direction. Thus, even if Lee was combined with Schein, this would simply result in a touchpad instead of a roller, and not provide the missing two-directional feature.

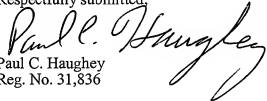
Accordingly, claims 5-6 and 11 are not obvious from Schein in view of Lee.

**CONCLUSION**

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 415-576-0200.

Respectfully submitted,

  
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